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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,041	09/29/1999	JOHN M. PACKES JR.	WD2-99-030	4801

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WALKER DIGITAL
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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,041

Applicant(s)

Packes et al.

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 18, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above, claim(s) 43-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 53-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 29, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-37 and 53-56, drawn to a method of completing a sale.
 - II. Claims 38-42, drawn to computer readable medium.
 - III. Claims 43-52, drawn to a system to authorize conveyance of a product before the final sale.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the independent method claims could be achieved without a computer at all. For example, going to a flea market, trying something on and haggling over the price or terms. The examiner has considered that the automated capability of the method claims inherently will have the computer readable medium configured to accomplish them, therefore group II will be examined with group I.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Dean Alderucci on 1/16/02 a provisional election was made without traverse to prosecute the invention of groups I and II, claims 1-42 and 53-56.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 43-52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The following is an action on the merits:

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the egress control device, product marker and receipt must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

7. Per the above drawing objections, corrected drawings are required in reply to this office action to avoid abandonment of the application. The objection to the drawings will not be held in

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abeyance. If the reply does not include corrected drawings or a reply to the drawing requirements, the reply should be held non-responsive.

The above new guidelines are set forth in:

Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,
65 Fed. Reg. 57023 (Sept. 20, 2000)

Drawings in Patent Application Publications and Patents, 1242 Off. Gaz. Pat. Office 114
(Jan. 16, 2001)

The Memorandum on "Procedures for Treatment of Drawings in Utility Applications"
from Esther M. Kepplinger, Deputy Commissioner for Patent Operations, on May 3, 2001 to
Patent Examining Corps Directors

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 28-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 28-30 recite an egress control device, product markers, and e-receipts but

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merely mentions in the specification on pages 15 and 17 that they are part of POS terminal 210 and Kiosk 220. There is no enablement of how they are implemented.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 55-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55, line 5, recites "the final price". This may be a different price from "a final price" recited in claim 53 from which claim 55 depends.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 5, 12, 13, 15-19, 24-27, 31-42 and 53-56, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (5,794,207).

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Walker et al. ('207) shows, figure 12, a commercial network system designed to facilitate buyer driven conditional purchase offers. In this system the buyer creates a conditional purchase offer (CPO) (default value/price, non-final sales price term), with tracking numbers (customer identification) and a CPO database 265. A CPO is created by specifying the subject of the goods he wishes to purchase, a description of the goods he wishes to obtain, and any other conditions the buyer requires. For example, a typical CPO could specify that the buyer wants to purchase a block of four airline tickets from Chicago's O'Hare Airport to Dallas, Tex., the tickets must be from any of the six largest U.S. carriers, the buyer is willing to change planes no more than once so long as the scheduled layover is less than two hours, and the buyer is willing to pay \$180 per ticket, plus any applicable taxes. (these are value parameters, including price). Figure 12 shows step 1200 where the seller transfers goods to buyer (conveying product to a customer before an associated transaction term finalized, final sales price) This transfer could involve the delivery of physical goods as well as digital goods. Physical goods might include cars, jewelry, computer equipment, etc. Digital goods might include documents, tickets, access codes, etc. In the Walker et al. system, if the customer is dissatisfied, he seeks damages or seek replacement (column 30, lines 62-63) (a value proposal submitted and received after customer took possession, first override value, includes price and other value variables). The original CPO value and the sought value amount may be compared by an arbiter who may submit another resolution (second override value) The components of proposed values, such price, submitted may be high or lower

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depending on who submitted the proposed value and the combination of components. Software to run the Walker et al. system is inherent.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4, 6-11, 14 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., as applied in claims 1, 12, and 26 in view of Bloomberg et al. (from IDS) and Vig.

Walker et al. shows all of the limitations of the claims except for specifying interest rates, warranties, time limits, comparing competing products, egress control devices, product markers and receipts.

Vig teaches, column 45, lines 54-60, a system for providing non-subjective valuing. In this system, Vig teaches many components of "value" including financing (interest rates) and warranty in order to quantify value in order to make better decisions.

Based on the teaching of Vig, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Walker et al. system to incorporate interest

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rates and warranties as part of its CPO in order to quantify value in order to make better decisions.

Bloomberg et al. teaches, figure 1, a price protection system which is run for a distinct period of time in order to bring closure to the transaction and compares prices with competing producers in order to establish the best prices available.

Based on the teaching of Bloomberg et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Walker et al. system to incorporate a time limit before final sale in order to bring closure to the transaction and to incorporate that the arbiter use and compare competing producer pricing in order to establish the best prices available so that a fair decision may be obtained.

The examiner takes official notice that the use of egress control devices, product markers and receipts would have been obvious to one of ordinary skill in the art in order to facilitate sales.

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Walker et al. system to incorporate the use of egress control devices, product markers and receipts in order to facilitate sales.

Conclusion

Any inquiry concerning this communication should be directed to Michael Cuff at telephone number (703) 308-0610.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900. The fax phone number for this Group is (703) 746-7239. (After Final special fax number (703) 746-7238)

Michael Cuff 1/28/02
Michael Cuff
January 28, 2002